

## **REMARKS/ARGUMENTS**

Applicant responds herein to the Office Action dated June 5, 2009.

Claims 1, 3-12 and 14-17 remain pending in the most recent Office Action. Claim 8 has been withdrawn from consideration pursuant to Examiner's Restriction Requirement, and Applicant's election. Favorable reconsideration is kindly requested.

### **Rejection under 35 U.S.C. § 103**

Claims 1, 3-6 and 9-12 are rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent Application Publication No. 2002/0135891 by Kimura, *et al.* ("Kimura") in view of U.S. Patent No. 4,139,267 to Minoura ("Minoura"). Applicant respectfully traverses the rejection, for at least the following reasons.

Independent claims 1 and 12 are amended above to clarify that the passive aberration correction optical elements are chosen from plural sets of such elements. Further, the elements comprising each such set provide correction for mutually different types of aberration from the other sets. Additionally, within each set, each element provides correction for a mutually different sign and quantity of aberration as compared to other passive aberration correction optical elements within the same set. Support for this amendment is found generally throughout the original specification as filed, for example at Figs. 2-5 and their accompanying description. No new matter has been added.

In the Office Action's "Response to Arguments", the Office Action avers that "the lenses of Minoura act together to correct for mutually different types... signs... and... quantities of aberration," citing Col. 4, Table 1 (Office Action, p. 9). Applicant respectfully disagrees with this application of the reference with respect to the claimed language. The claim language as previously presented did not concern the combined effect of one or more lenses used together, giving a compound effect of correcting multiple types, signs and quantities of aberration. Moreover, this combined effect was to be expected from Applicant's disclosure. Rather, the claims specifically recited that each passive aberration correction optical element provided correction for a mutually different type, sign and quantity of aberration, from the other passive aberration correction optical elements, a feature that is neither nor suggested by Minoura nor Kimura. The Office Action *tacitly* admits such by its characterization of the claim language. As Table 1 of Minoura illustrates, the types, signs and quantities of aberration corrected exceed the number of correction elements, leading to the inescapable conclusion that each correction

element used does not correct for a mutually different type, sign, or quantity of aberration. Rather, the correction elements are compound, leading to a need for innumerable permutations of correction elements to correct for the types of aberration caused by manufacturing and adjustment errors that vary from one optical head device to another. The purported combination of Kimura and Minoura does not achieve the simplicity and efficiency to be gained according to Applicant's disclosure.

Notwithstanding the above-noted deficiency of the references with respect to the previously presented claim language, independent claims 1 and 12 are amended above to refine the distinction between the claimed features and the purported combination of Kimura and Minoura. Specifically, claims 1 and 12 as amended above that passive aberration correction optical elements are chosen from among plural sets of passive aberration correction optical elements. Further, each such set contains passive aberration correction optical elements that provide correction for a type of aberration that is mutually different than the types of aberration correction provided by the elements of the other sets. Furthermore, within each such set, the passive aberration correction optical elements provide correction for mutually different signs and quantities of aberration from other such elements within the same set.

These amended features of claims 1 and 12 are neither taught nor suggested by the purported combination of Kimura and Minoura. Neither reference teaches or suggests selecting passive aberration correction optical elements from among plural sets or such elements; nor that the elements of a given set provide correction for a type of aberration that is mutually different than the types of aberration correction provided by the elements of the other sets; nor that within each set, the passive aberration correction optical elements provide correction for mutually different signs and quantities of aberration from other such elements within the same set.

Therefore, even presuming that there were some apparent reason to combine the references as proposed in the Office Action, their proposed combination does not teach all features of present claims. It remains well-settled that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicant respectfully submits that independent claims 1 and 12 are therefore patentably distinguished over Kimura and Minoura, taken singly or in combination.

Claims 3-6 and 9-11 each depend from independent claim 1. These dependent claims are each separately patentable, but in the interest of brevity they are offered as patentably for at least the same reasons as their respective underlying independent base claims, the features of which are incorporated by reference. Applicant respectfully submits that the rejection has been obviated, and kindly requests favorable reconsideration and withdrawal.

Claim 7 is rejected under 35 U.S.C. § 103(a) as obvious over Kimura in view of Minoura, and further in view of U.S. Patent No. 6,084,843 to Abe, *et al.* (“Abe”). Claim 14 is rejected under 35 U.S.C. § 103(a) as obvious over Kimura in view of Minoura, and further in view of U.S. Patent No. 6,967,916 to Sano, *et al.* (“Sano”). Claims 15-17 are rejected under 35 U.S.C. § 103(a) as obvious over Kimura in view of Minoura, and further in view of U.S. Patent No. 5,126,994 to Ogawa, *et al.* (“Ogawa”). Applicant respectfully traverses the rejections, for at least the following reasons.

Each of claims 7 and 14-17 depend from either independent claim 1 or 12, and incorporate by reference the features of their respective underlying independent base claim. None of Abe, Sano or Ogawa are alleged to remedy the above noted deficiencies of Kimura and Minoura with respect to these underlying independent base claims, as amended. Therefore, even presuming that there were some apparent reason to combine the references as proposed in the Office Action, their proposed combination does not teach all features of present claims. See, *Royka, supra*. Applicant respectfully submits that claims 7 and 14-17 are therefore patentably distinguished over Kimura, Minoura, Abe, Sano and Ogawa, taken singly or in any combination. Favorable reconsideration and withdrawal of the rejection is kindly requested.

### Conclusion

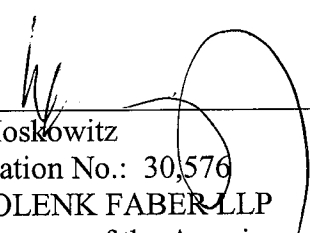
In view of the foregoing, it is respectfully submitted, the claims of record clearly differentiate from and are patentable over the art of record.

Early and favorable consideration of the present application is earnestly solicited.

THIS CORRESPONDENCE IS BEING  
SUBMITTED ELECTRONICALLY  
THROUGH THE PATENT AND  
TRADEMARK OFFICE EFS FILING  
SYSTEM ON February 11, 2010.

MM/DJT:lf

Respectfully submitted,



---

Max Moskowitz  
Registration No.: 30,576  
OSTROLENK FABER LLP  
1180 Avenue of the Americas  
New York, New York 10036-8403  
Telephone: (212) 382-0700